

B. REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1-3, 18-20, 39, 41-44, 59-61, 80, 82 and 83 have been amended added. Hence, Claims 1-84 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability. All issues raised in the Office Action mailed January 10, 2005 are addressed hereinafter.

REJECTION OF CLAIMS 1-41 UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-41 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims have been amended to address the specific issues identified in the Office Action. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-41 under 35 U.S.C. § 112, second paragraph, is respectfully requested.

REJECTION OF CLAIMS 1-5, 7, 8-20, 29, 42-46, 48-61, 70 AND 83 UNDER 35 U.S.C. § 103(a)

Claims 1-5, 7, 8-20, 29, 42-46, 48-61, 70 and 83 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess et al.*, U.S. Patent No. 5,696,701 (hereinafter “*Burgess*”) in view of *Grimm et al.*, U.S. Patent No. 6,317,868 (hereinafter “*Grimm*”). It is respectfully submitted that Claims 1-5, 7, 8-20, 29, 42-46, 48-61, 70 and 83, as amended, are patentable over *Burgess* and *Grimm* for at least the reasons provided hereinafter.

CLAIM 1

Claim 1, as amended, is directed to a method for measuring client side performance that recites:

“intercepting an item that is to be sent to a client process prior to arrival of the item at the client process;
modifying the item to produce a modified item that includes code which causes one or more processors on a client device to perform the steps of:
measuring performance related to a service associated with the item, and
performing one or more acts based on a measurement resulting from said step of measuring performance; and
sending the modified item to the client process.”

It is respectfully submitted that Claim 1 is patentable over *Burgess* and *Grimm* because Claim 1 recites one or more limitations that are not taught or suggested by *Burgess* or *Grimm*, considered alone or in combination. For example, it is respectfully submitted that the Claim 1 limitations “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process” are not taught or suggested by *Burgess* and *Grimm*, considered alone or in combination. The Office Action asserts that these limitations are not taught or suggested by *Burgess* and relies upon *Grimm* for these limitations. No further discussion of *Burgess* is therefore required with respect to these limitations.

Grimm describes an approach for modifying a software component to implement a security policy defined for a site where the software component is executed. When a software component needs to be loaded for execution, i.e., linked and activated, by a computer, an introspection service 13 intercepts the software component for analysis. An interposition service 17 modifies the software component to adhere to the security policies of the computer. This includes adding code to the original software component to generate a modified software

component 21. The modified software component 21 is then loaded and made available for execution in place of the original software component. When executed, the modified software component 21 invokes the necessary security services, which maintains the security state of the computer.

A distinction between the method recited in Claim 1 and the teachings of *Grimm* is that the approach recited in Claim 1 involves intercepting an item that is to be sent to a client and instead providing a modified item to the client. To the extent *Grimm* teaches or suggests intercepting an item, it is in the context of intercepting a software component while it is being loaded at a site where the software component will be executed. There is no mention or suggestion in *Grimm* of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process” as recited in Claim 1. In addition, Claim 1 recites “sending the modified item to the client process” in *Grimm*, the modified software component is loaded at the site where the software component will be executed. *Grimm* does not teach or suggest sending a modified software component to a client. It is therefore respectfully submitted that Claim 1 recites one or more limitations that are not taught or suggested by *Burgess* and *Grimm*, considered alone or in combination, and that Claim 1 is therefore patentable over *Burgess* and *Grimm*.

CLAIMS 2-5, 7, 8-20 AND 29

Claims 2-5, 7, 8-20 and 29 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-5, 7, 8-20 and 29 are patentable over *Burgess* and *Grimm* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is respectfully submitted that Claims 2-5, 7, 8-20 and 29 recite additional limitations that independently render them patentable over *Burgess* and *Grimm*.

For example, Claim 18 recites “determining a type associated with the item; and determining whether to perform said step of modifying the item based on the type of the item.” *Grimm* describes determining whether to generate a modified software component based upon information determined by introspection service 13. More specifically, security policy service 15 determines the security policy that is applicable to the software component. *Grimm* does not teach or suggest, however, determining whether to generate a modified software component based upon a type associated with the software component. Since there are many ways this could be done, in the absence of some teaching or suggestion of using a type associated with a software component to determine whether to generate a modified software component, it is respectfully submitted that the additional limitations recited in Claim 18 are not taught or suggested by *Grimm*.

CLAIMS 42-46, 48-61, 70 AND 83

Claims 42-46, 48-61, 70 and 83 are similar to Claims 1-5, 7, 8-20 and 29, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 42-46, 48-61, 70 and 83 are patentable over *Burgess* and *Grimm* for at least the reasons set forth herein with respect to Claims 1-5, 7, 8-20 and 29.

In view of the foregoing, it is respectfully submitted that Claims 1-5, 7, 8-20, 29, 42-46, 48-61, 70 and 83, as amended, are patentable over *Burgess* and *Grimm*. Accordingly, reconsideration and withdrawal of the rejection of Claims 1-5, 7, 8-20, 29, 42-46, 48-61, 70 and 83 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* is respectfully requested.

REJECTION OF CLAIMS 6 AND 47 UNDER 35 U.S.C. § 103(a)

Claims 6 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Dustan et al.*, U.S. Patent No. 5,884,312 (hereinafter “*Dustan*”). It is respectfully submitted that Claims 6 and 47 are patentable over *Burgess*, *Grimm* and *Dustan*, considered alone or in combination, for at least the reasons provided hereinafter.

Claim 6 depends from Claim 1 and includes all of the limitations of Claim 1. Claim 47 recites limitations similar to Claim 6, except in the context of a computer-readable medium. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Dustan* and it is understood that *Dustan* was relied upon in the Office Action for the limitations of Claim 6 and not for the limitations of Claim 1. *Dustan* describes an approach for securely accessing information from disparate data sources through a network. There is no description or suggestion in *Dustan*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 6 and 47 are not taught or suggested by *Burgess*, *Grimm* and *Dustan*, considered alone or in combination, and that Claims 6 and 47 are therefore patentable over *Burgess*, *Grimm* and *Dustan*. Accordingly, reconsideration and withdrawal of the rejection of Claims 6 and 47 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Dustan* is respectfully requested.

REJECTION OF CLAIMS 24-27 AND 65-68 UNDER 35 U.S.C. § 103(a)

Claims 24-27 and 65-68 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Simonoff et al.*, U.S. Patent No. 5,944,784 (hereinafter “*Simonoff*”). It is respectfully submitted that Claims 24-27 and 65-68 are patentable over *Burgess*, *Grimm* and *Simonoff*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 24-27 depend from Claim 1 and include all of the limitations of Claim 1. Claims 65-68 recite limitations similar to Claims 24-27, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Simonoff* and it is understood that *Simonoff* was relied upon in the Office Action for the limitations of Claims 24-27 and not for the limitations of Claim 1. *Simonoff* describes operating methods for a universal client device. There is no description or suggestion in *Simonoff*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 24-27 and 65-68 are not taught or suggested by *Burgess*, *Grimm* and *Simonoff*, considered alone or in combination, and that Claims 24-27 and 65-68 are therefore patentable over *Burgess*, *Grimm* and *Simonoff*. Accordingly, reconsideration and withdrawal of the rejection of Claims 24-27 and 65-68 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Simonoff* is respectfully requested.

REJECTION OF CLAIMS 28, 30, 69 AND 71 UNDER 35 U.S.C. § 103(a)

Claims 28, 30, 69 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Hoskins et al.*, U.S. Patent No. 6,108,662 (hereinafter “*Hoskins*”). It is respectfully submitted that Claims 28, 30, 69 and 71 are patentable over *Burgess*, *Grimm* and *Hoskins*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 28 and 30 depend from Claim 1 and include all of the limitations of Claim 1. Claims 69 and 71 recite limitations similar to Claims 28 and 30, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Hoskins* and it is understood that *Hoskins* was relied upon in the Office Action for the limitations of Claims 28 and 30 and not for the limitations of Claim 1. *Hoskins* describes a system software solution for controlling an enterprise. There is no description or suggestion in *Hoskins*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 28, 30, 69 and 71 are not taught or suggested by *Burgess*, *Grimm* and *Hoskins*, considered alone or in combination, and that Claims 28, 30, 69 and 71 are therefore patentable over *Burgess*, *Grimm* and *Hoskins*. Accordingly, reconsideration and withdrawal of the rejection of Claims 28, 30, 69 and 71 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Hoskins* is respectfully requested.

REJECTION OF CLAIMS 31, 32, 72 AND 73 UNDER 35 U.S.C. § 103(a)

Claims 31, 32, 72 and 73 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Nasu et al.*, U.S. Patent No. 5,671,402 (hereinafter “*Nasu*”). It is respectfully submitted that Claims 31, 32, 72 and 73 are patentable over *Burgess*, *Grimm* and *Nasu*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 31 and 32 depend from Claim 1 and include all of the limitations of Claim 1. Claims 72 and 73 recite limitations similar to Claims 31 and 32, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Nasu* and it is understood that *Nasu* was relied upon in the Office Action for the limitations of Claims 31 and 32 and not for the limitations of Claim 1. *Nasu* describes a method for evaluating a data processing rate using simulation. There is no description or suggestion in *Nasu*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 31, 32, 72 and 73 are not taught or suggested by *Burgess*, *Grimm* and *Nasu*, considered alone or in combination, and that Claims 31, 32, 72 and 73 are therefore patentable over *Burgess*, *Grimm* and *Nasu*. Accordingly, reconsideration and withdrawal of the rejection of Claims 31, 32, 72 and 73 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Nasu* is respectfully requested.

REJECTION OF CLAIMS 33-41, 74-82 AND 84 UNDER 35 U.S.C. § 103(a)

Claims 33-41, 74-82 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and further in view of *Raz et al.*, U.S. Pub. No. 2001/0037400 A1 (hereinafter “*Raz*”). It is respectfully submitted that Claims 33-41, 74-82 and 84 are patentable over *Burgess*, *Grimm* and *Raz*, considered alone or in combination, for at least the reasons provided hereinafter.

Claims 33-41 depend from Claim 1 and include all of the limitations of Claim 1. Claims 74-82 and 84 recite limitations similar to Claims 33-41, except in the context of computer-readable media. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Burgess* and *Grimm*. It is also respectfully submitted that these limitations are also not taught or suggested by *Raz* and it is understood that *Raz* was relied upon in the Office Action for the limitations of Claims 33-41 and not for the limitations of Claim 1. *Raz* describes a method for decreasing the user-perceived system response time in Web-based systems. There is no description or suggestion in *Raz*, however, of “intercepting an item that is to be sent to a client process prior to arrival of the item at the client process; modifying the item to produce a modified item” and “sending the modified item to the client process,” as recited in Claim 1. It is therefore respectfully submitted that Claims 33-41, 74-82 and 84 are not taught or suggested by *Burgess*, *Grimm* and *Raz*, considered alone or in combination, and that Claims 33-41, 74-82 and 84 are therefore patentable over *Burgess*, *Grimm* and *Raz*. Accordingly, reconsideration and withdrawal of the rejection of Claims 33-41, 74-82 and 84 under 35 U.S.C. § 103(a) as being unpatentable over *Burgess* in view of *Grimm* and in further view of *Raz* is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,
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on March 24, 2005 by


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